



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,930	09/29/2006	Christian Borowski	246472010400	5776
25227 7590 07/27/2009 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102				
EXAMINER				
GOFF II, JOHN L				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
07/27/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/594,930

**Applicant(s)**

BOROWSKI ET AL.

**Examiner**

John L. Goff

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-8 and 10-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 2-8 and 10-14 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 29 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date 9/29/06, 3/16/07.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 10 recites the limitation "the implant" in line 3. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2-8, 10(2), 10(3), 10(12), and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Mormann (U.S. Patent 5,939,211).

Mormann discloses a method for producing a blank for a permanent dental crown of interconnected parts comprising forming a support (the lowermost layer of 32 in Figure 4) layer and a tooth module (at least one or all of the layer(s) 32 above the lowermost layer 32 in Figure 4) stack of layers from a same material such as ceramic in a first process to impart a high surface

quality, joining the support to the underside of the tooth module to form the blank as one unit in a second process such as adhesive bonding wherein the support and the tooth module are connected over their full surface, and forming a preparation (50 of Figures 8 and 9) on an underside of the tooth module by milling configured to serve as a connection to an anchor arranged in the jaw of a subject (Column 3, lines 5-17 and 65-67 and Column 4, lines 1-31 and Column 5, lines 66-67 and Column 6, lines 1-6 and 66-67 and Column 7, lines 1-10).

Regarding claims 4-6 and 10, Mormann teaches a support that is a combination of a tooth module connection part (the lowermost layer of 32 in Figure 4) and a lateral securing part (18 of Figure 2) designed as an extension arm. The securing part is a formed part taking up the forces that occur during machining and is designed such that it extends at least along the height of the tooth module.

Regarding claim 8, the tooth module is a front tooth module.

Regarding claims 10(12), 10(2), 10(3), and 14, Mormann teaches the support (the lowermost layer of 32 in Figure 4) is configured for connection to a machine adapter (18 of Figure 2) with at least one channel (19 of Figure 4) capable of delivering molding material or adhesive for the blank, it being noted "for delivering molding material or adhesive for the implant" does not specifically require molding material or adhesive is actually delivered rather the channel must simply be capable of delivering molding material or adhesive the channel taught by Mormann capable of having a molding material or adhesive flow through it.

***Claim Rejections - 35 USC § 103***

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mormann.

Mormann is described above in full detail. The tooth module taught by Mormann appears to be a front tooth module. In the event it is shown the tooth module is not necessarily a front tooth module the following rejection would apply. Mormann is not limited to the tooth module as a module for any particular tooth. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the tooth module in Mormann a module for any tooth including a front tooth only the expected results of forming a permanent dental crown for a front tooth being achieved.

7. Claims 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mormann in view of Collito (U.S. Patent 3,250,003).

Mormann is described above in full detail. Mormann is silent as to a specific means for delivering the adhesive between the layers. It was extremely well known in the art to deliver an adhesive to a substrate using a machine adapter with at least one channel for delivering adhesive to the substrate (32 of Figure 4) as evidenced by Collito (Column 4, lines 56-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to deliver the adhesive as taught by Mormann using a well known machine adapter with at least one channel for delivering the adhesive as shown by Collito only the expected result of delivering the adhesive between the layers being achieved.

Regarding claim 14, the support taught by Mormann is capable of being connected to the machine adapter taught by Collito in some manner, e.g. adhesively, such that the support is designed to be configured for connection to the machine adapter, it being noted the claim does

not require the support is actually connected to the machine adapter nor does the claim require any particular design or configuration.

*Allowable Subject Matter*

8. The prior art of record fails to teach or suggest a method for producing a blank for a permanent dental crown as claimed including each of a tooth module, a support comprising a tooth module connection part connected over the full surface of the underside of the tooth module and a securing part designed as an extension arm, and a machine adapter with at least one channel for delivering molding material or adhesive for the blank wherein the securing part designed as an extension arm is connected to the machine adapter. If claim 14 were amended to positively require “the securing part is connected to the machine adapter” then claim 14 which depends on claim 10(4) (and thus also 10(5)) would contain allowable subject matter, i.e. the claim 10 which depends on claim 4 requiring the securing part including the claim 10(4) rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is (571)272-1216. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John L. Goff/  
Primary Examiner, Art Unit 1791